

## REMARKS

1. In response to the Office Action mailed November 10, 2010, Applicant respectfully requests reconsideration. Claims 1 and 39-71 were last presented for examination. In the outstanding Office Action, claims 1, 51-66 and 71 are indicated as being allowable, and claims 39-50 and 67-70 were rejected. No claims have been amended, added or cancelled. Upon entry of this paper, claims 1 and 39-71 will be pending in this application. Of these thirty-four (34) claims, four (4) claims (claims 31, 40 and 48) are independent.
2. Based upon the following Amendments and Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered and withdrawn.

### *Allowable Subject Matter*

3. Applicant thanks the Examiner for indicating that claims 1, 51-66 and 71 are directed to allowable subject matter.

### *Claim Rejections under §101*

4. Claims 39-50 are rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully requests that this rejection be reconsidered and withdrawn for at least the following reasons.
5. In the Office Action, the Examiner states that “[t]he claim appears to be combining two statutory classes. The preamble states that the claim is an apparatus, while the body of the claim is directed toward a method.” (See, Office Action, pg. 2.) Applicant disagrees and submits that claim 39 recites only an apparatus, and not the steps of a method. More specifically, Applicant’s claim 39 recites “an apparatus configured to interface with an auditory stimulation system having a plurality of channels.” (See, Applicant’s claim 39, above; emphasis added.) Applicant’s claim 39 also recites that “the apparatus is further configured to establish a first current level profile . . . ; display a graphical representation of the first current level profile . . . instruct the auditory stimulation system . . .” and “obtain a response . . . ; adjust . . . more than one of the first current level settings . . . ; and

**provide** the second current level profile . . . .” (See, Applicant’s claim 39, above; emphasis added.) Accordingly, Applicant’s claim 39 recites an apparatus **configured to perform various functions**. Applicant’s claim 39 does not recite the performance of steps of a method.

6. Additionally, the Examiner appears to be relying on section 2173.05(p)(II) of the Manual of Patent Examining Procedure (MPEP), which states that “[a] single claim which claims both an apparatus and the method steps of using the apparatus” may “be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a ‘process’ nor a ‘machine,’ but rather embraces the overlap of two different statutory classes of invention.” (See, MPEP § 2173.05(p)(II) (citing *Ex parte Lyell*, 17 USPQ2d 1548, 1551 (Bd. Pat. App. & Inter. 1990).) Moreover, as support for this ground of rejection, the MPEP cites *Ex parte Lyell*. The claim at issue in that case recites, in part, “[a]n automatic transmission tool in the form of a workstand **and a method for using the same** comprising: a support means; and [sic] internally splined sleeve . . . a threaded adjustment bolt . . . **and further comprising the steps of** 1. positioning the output end . . . 2. removing the internal components . . . .” (See, *Ex parte Lyell* at 1549; emphasis added.) Applicant’s claim 39 does not recite both an apparatus and a method of using the apparatus, as in the claim at issue in *Ex parte Lyell*. Rather, as noted above, Applicant’s claim 39 recites an apparatus configured to perform various functions. As such, Applicant submits that the ground of rejection stated above is wholly inapplicable to Applicant’s claim 39.

7. For at least the reasons discussed above, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

### ***Claim Rejections under §112***

8. Claims 39-50 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Applicant respectfully requests that this rejection be reconsidered and withdrawn for at least the following reasons.

9. In the Office Action, the Examiner alleges that “claim 39 recites steps performed by an apparatus but fails to provide any elements in the device to perform the steps. It is unclear what elements in the apparatus performs each of the steps.” (See, Office Action, pg. 2.) However, as noted above, Applicant’s claim 39 does not recite “steps performed by an apparatus,” but instead recites an apparatus configured to perform various functions. Additionally, the Federal Circuit has stated that a “patent applicant is free to recite features of an apparatus either structurally or functionally.” (*In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).) This premise has been adopted by the USPTO, as reflected in the MPEP, which explains that an “[a]pplicant may use functional language . . . or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.” (See, MPEP §2173.01.) Accordingly, Applicant submits that the use of functional limitations does not render Applicant’s claim 39 indefinite.

10. The MPEP further states that “[t]he examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” (See, MPEP §2173.02.) Additionally, “[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” (See, MPEP §2173.02; emphasis added.) Applicant submits that the functional limitations of claim 39 are reasonably clear and precise, and the Examiner does not assert that the functional limitations are unclear or imprecise. Rather, the Examiner asserts that “[i]t is unclear what element in the apparatus performs each of the steps.” (See, Office Action, pg. 2; emphasis added.) However, the Examiner fails to identify any authority supporting the Examiner’s apparent assertion that a claim is indefinite unless it specifies a particular structure that corresponds to each functional limitation of a claim.

11. For at least the reasons discussed above, Applicant submits that this rejection is improper. As such, Applicant respectfully requests that the rejection be reconsidered and withdrawn.

***Claim Rejections under §103***

12. Claims 67-70 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,157,861 to Faltys et al. (hereinafter, "Faltys '861") in view of U.S. Patent No. 6,289,247 to Faltys et al. (hereinafter, "Faltys '247"). Without addressing the propriety of the Examiner's combination of Faltys '861 and Faltys '247, Applicant respectfully requests reconsideration and withdrawal of this rejection for at least the following reasons.
13. Faltys '861 is directed to "an implantable cochlear stimulator (ICS) and a method for fitting such ICS to a particular patient." (*See*, Faltys '861, col. 1, lns. 10-12.) More specifically, Faltys '861 discloses a process for "determin[ing] the patient thresholds for each channel of an ICS." (*See*, Faltys '861, col. 10, lns. 25-28.) The process includes applying an "evoked-potential-determining loop" to each channel of the ICS to determine the desired stimulation threshold for each channel. (*See*, Faltys '861, col. 12, lns. 33-34; and col. 11, lns. 38-43.) The evoked-potential-determining loop includes applying stimuli of various intensity levels to a recipient, and determining whether each stimuli evokes a response from the recipient. (*See*, Faltys '861, col. 11, ln. 49 through col. 12, ln. 18.)
14. As noted above, the evoked-potential-determining loop of Faltys '861 is applied to each channel of the ICS, thereby measuring the desired stimulation threshold for each channel. Accordingly, Applicant submits that Faltys '861 discloses measuring the threshold for each channel. Faltys '861, however, does not disclose determining current level settings for each of a plurality of channels based on thresholds measured for less than all of those channels. (*See*, Applicant's claim 67, above.) Rather, Faltys '861 discloses measuring the threshold for each and every channel. As such, Applicant submits that Faltys '861 fails to disclose or render obvious "measuring a first threshold for each channel of a first subset of the plurality of channels, wherein the first subset comprises fewer than all of the channels; and determining from the measured first thresholds the current level setting for each channel of the plurality of channels," as recited in Applicant's claim 67.
15. In the rejection of claim 67, the Examiner relies secondarily upon Faltys '247. Applicant submits that Faltys '247 fails to cure the deficiencies of Faltys '861 for at least the

following reasons. Faltys '247 discloses "a universal method and/or system whereby multiple speech processing strategies can be easily and quickly selected and modified for application to a patient having a multichannel implantable cochlear prosthesis." (See, Faltys '247, col. 4, lns. 14-18.) A selected speech processing strategy generates control signals to control an ICS. (See, Faltys '247, col. 9, lns. 46-49.) The control signals "specify or define the polarity, magnitude, location . . . and timing . . . of the stimulation current that is generated by the ICS." (See, Faltys '247, col. 9, lns. 49-54.) Faltys '247 also discloses that, when fitting an ICS to a patient, signals that simulate acoustic signals may be applied to the patient to test the patient's threshold levels. (See, Faltys '247, col. 11, lns. 27-29 and 45-51.) Faltys '247 further discloses a fitting session in which a speech processing strategy is selected and control signals are generated in accordance with the selected speech processing strategy. (See, Faltys '247, col. 21 ln. 33 through col. 22, ln. 13.) The control signals are applied to an ICS, which applies electrical stimulation to the patient based on the control signals, and the "control signals are adjusted, as required," in response to feedback from the applied stimulation. (See, Faltys '247, col. 22, lns. 14-29.)

16. Applicant submits that Faltys '247 generally discloses testing a patient's threshold levels, but fails to specifically disclose determining current level settings for each of a plurality of channels based on thresholds measured for less than all of those channels. (See, Applicant's claim 67, above.) Accordingly, Applicant submits that Faltys '247 does not cure, and the Examiner has not alleged that it cures, the above-noted deficiencies of Faltys '861.

17. Additionally, Applicants note that on page 3 of the Office Action, the Examiner contends that "Faltys 247 discloses a multi-channel stimulator that establishes a speech strategy . . . and adjusts based on all channels or a subset of channels (Col. 32, ll. 27-36)," and relies upon claims 9 and 10 of Faltys '247 in support of this contention. (See, Office Action, pg. 3.) However, claims 9 and 10 recite speech processing strategies that specify that either two or four channels are to be stimulated simultaneously. Claims 9 and 10 of Faltys '247 do not disclose determining current level settings for each of a plurality of

channels based on thresholds measured for less than all of those channels. (See, Applicant's claim 67, above.)

18. For at least these reasons, Applicant submits that Faltys '247 fails to cure the deficiencies of Faltys '861. As such, Applicant submits that Faltys '861 and Faltys '247, individually and in combination, fail to disclose or render obvious Applicant's claim 67. Accordingly, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

***Dependent claims***

19. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

***Drawings***

20. Applicant notes that the Examiner has failed to check the boxes on the Office Action Summary either accepting or objecting to the drawings submitted December 22, 2004 in this application. Applicant respectfully requests that the Examiner indicate the acceptance of the drawings in the next official communication.

***Priority under 35 U.S.C. 119***

21. Applicant also notes that the Examiner has failed to acknowledge Applicant's claim for foreign priority on the Office Action Summary. Applicant respectfully requests that the Examiner acknowledge Applicant's claim for foreign priority and receipt of a certified copy of the foreign priority document in the next official communication.

## CONCLUSION

22. In view of the foregoing, Applicant respectfully submits that this application is now in condition for allowance. A notice to this effect is respectfully requested.
23. Applicant makes no admissions by not addressing any outstanding rejections or bases of rejections. Furthermore, Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Thus, cancellations and amendments of above claims, are not to be construed as an admission regarding the patentability of any claims.

Dated: January 10, 2011

Respectfully submitted,

/Michael G. Verga/  
Michael G. Verga  
Registration No.: 39,410  
KILPATRICK TOWNSEND &  
STOCKTON LLP  
607 14<sup>th</sup> Street, NW  
Suite 900  
Washington, DC 20005  
(404) 815-6500  
(404) 815-6555 (Fax)  
Attorney for Applicant